

Remarks

By the foregoing amendment, Claim 1 has been amended to recite oxygen is present in an amount of 10% to 150% stoichiometric excess of oxygen over the fuel gas. The amendment to claim 1 is supported by original claim 10. In addition, claims 10, 19 and 27 have been cancelled and dependent claims amended accordingly. It is respectfully requested this amendment be entered as it does not constitute new matter or require a new search.

Claims 1, 16, 17, 18, 25, 26 and 33 have been rejected under 35 U.S.C. § 102(e) as anticipated by US Patent No. 6,261,524 to Herman et al..

Anticipation requires the presence in a single reference of each claim limitation. Lewmar Marine v. Barient, Inc., USPQ 2d 1766, 1767 (Fed. Cir. 1987). As noted above, Claim 1 has been amended to recite oxygen is present in an amount of 10% to 150% stoichiometric excess of oxygen over the fuel gas. As admitted by the Examiner, Herman et al. fail to disclose the amount of oxygen added as a mixture having 10 to 150% stoichiometric excess of oxygen over the fuel gas. Accordingly, Herman et al. fail to anticipate the claimed invention.

Claims 10-15, 19-24 and 27-32 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Herman et al. further in view of U.S. Patent No. 5,510, 093 to Bartz et al. More particularly, the Office Action states “Bartz et al is relied upon to teach a process for the combustive destruction of halogenated compounds with the addition of excess oxygen and a fuel to the waste gas stream...” It is respectfully submitted this reliance is misplaced..

Bartz et al disclose combustive destruction of halogenated compounds at a temperature of at least 1,900°F (1037.8°C).

As discussed at page 4, lines 7-12, a substantially increased temperature (about 1000°C) has heretofore been proven necessary to provide acceptable destruction rates, however the drawbacks of this approach include the production of large quantities of nitrogen oxides (NO_x) as well as reduced component lifetime. In contrast, the claimed invention provides a process in which the temperature is less than 1000°C with negligible production of NO_x (page 4, lines 16-19 of the specification).

There is no reason why one skilled in the art would be motivated to combine Herman et al. with Bartz et al. which teaches the use of a temperature of at least 1,900°F (1037.8°C) gas. The law is well established that it is improper to combine references which teach away from their combination. MPEP §2141.02 (*See* PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM CLAIMS, p. 2100-122).

Indeed, this combination is improper, as set forth in MPEP §2145(X)(D)(2), which is reproduced below:

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) (The claimed catalyst which contained both iron and an alkali metal was not suggested by the combination of a reference which taught the interchangeability of antimony and alkali metal with the same beneficial result, combined with a reference expressly excluding antimony from, and adding iron to, a catalyst.).

Accordingly it is respectfully submitted it is improper to combine Herman

et al and Bartz et al *which teaches away from* a process in which the temperature is less than 1000°C; and, neither Bartz et al. or Herman et al. render the claimed invention *prima facie* obvious.

In view of the foregoing claims 1, 11-18, 20-26, 28-33, all the pending claims, are in condition for allowance.

Prompt and favorable action is respectfully requested.

Respectfully submitted,



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